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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,879	12/11/2006	Roberto Defilippi	33033-1090	3660
45263	7590	04/23/2009		
MITCHELL P. BROOK LUCE, FORWARD, HAMILTON & SCRIPPS LLP 11988 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130			EXAMINER COLEMAN, KEITH A	
			ART UNIT	PAPER NUMBER
			3747	
			MAIL DATE	DELIVERY MODE
			04/23/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,879

Applicant(s)

DEFILIPPI, ROBERTO

Examiner

KEITH COLEMAN

Art Unit

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/21/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US Patent No. 6,216,675) in view of Brummer et al. (US Patent No. 5,445,130) and Watanabe et al. (US Patent No. 5,251,603).

With regards to claim 1, the patent to Bennett discloses a cooling device (28, Col. 3, Line 29, Col. 1, Lines 14-16, See Figure 1) for a fuel-recirculation circuit (Col. 3, Lines 28-32) from the injection system (14, Col. 2, Line 60, See Figure 1) to the tank (18, Col. 3, Line 12, See Figure 1) of a motor vehicle, which has a first opening and a second opening for connection to said recirculation circuit and comprises a pipe (28, See Figure 1) having a side wall (154, Col. 4, Line 28, See Figure 5) and a finned radiant body (32, Col. 3, Line 31) in a relationship of heat exchange with said pipe (28), end couplings (28, See Figure 1) connected hermetically to said pipe (28), an elongated body (28) housed in a through cavity (enclosed by fins 34, Col. 3, Line 32, See Figure 2) defined by said pipe (28), projections (32,34) radially interposed between said pipe (28) and said elongated body (28) to define internal passages traversed by said fuel, in that said projections (32, 34) are integrally formed on at least one of said pipe (28) and said elongated body (28), and in that said end couplings (See Figure 1) are connected to said pipe (28) only except positively disclosing the elongated body is made of polymeric material and is interference fitted in said through cavity. As to the polymeric material, the patent to Brummer et al. discloses an elongated body is made of polymeric material.

As to the new limitation of "in that said pipe is made of a metal material having a different coefficient of thermal expansion than the polymeric material," since Bennett

explicitly states that "other changes may be made in detail, especially in matters of shape, size, arrangement of the parts, order of steps or material of components within the principles of the invention", it would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the material of the elongated body of Bennett with a polymeric material in view of the teaching to Brummer et al., in order to have a material that is resistant to fuel and heat. Furthermore, as the interference fit, the patent to Watanabe et al. discloses an elongated body (36) is interference fitted in a cavity (See Figure 6). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the elongated body of Bennett and Brummer with wherein the elongated body (36) is interference fitted in a cavity in view of the teaching to Watanabe, in order to prevent temperature rise of gasoline or fuel in the fuel tank or a motor vehicle (Col. 1, Lines 6-8). See MPEP 2144.07. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious)

As to the newly added limitation of "having at least a tapered end longitudinally spaced from said couplings", the patent to Watanabe clearly shows the claimed limitation in Figure 5.

With regards to claim 2, the patent to Bennett discloses said radiant body (10) comprises a plurality of fins that are longitudinal with respect to said pipe (See Figure 2).

With regards to claim 3, the patent to Bennett discloses said longitudinal fins are arranged in spoke-like fashion with respect to said pipe (See Figure 2).

With regards to claim 4, the patent to Bennett discloses said elongated body (10) is coaxial to said pipe (24, See Figure 1).

With regards to claims 6 and 7, the patent to Bennett discloses said elongated body carries said projections in contact with said side wall of said pipe (24), thus defining said internal passages (See Figure 2).

With regards to claim 8, the patent to Bennett discloses said elongated body (10) has a circular cross section (See Figure 2).

With regards to claim 9, the combination of Bennett, Watanabe et al., and Brummer et al. discloses all the limitations of the claimed subject matter including Watanabe et al. discloses that the projections are helical.

With regards to claim 10 the patent to Bennett discloses characterized in that said projections are longitudinal (See Figures 1 and 2).

With regards to claim 11, the patent to Bennett discloses said at least one coupling comprises a substantially conical portion (138) housing a respective end (See Figures 1 and 2).

Response to Arguments

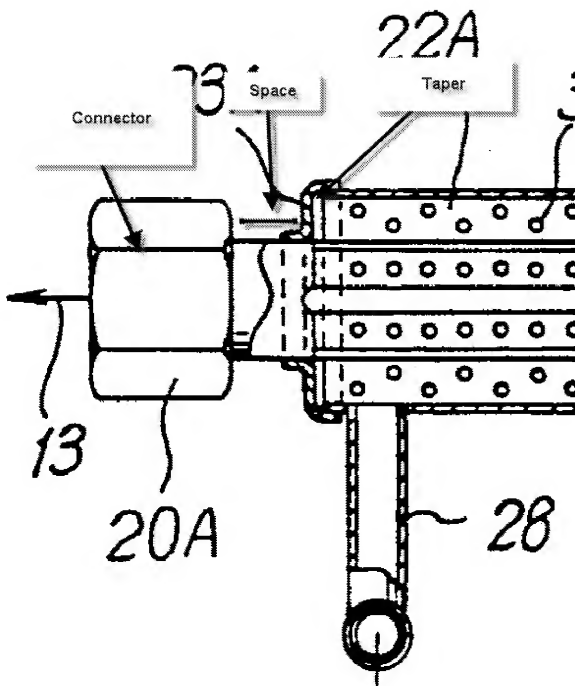
1. Applicant's arguments filed 1/16/2009 have been fully considered but they are not persuasive.

Applicant's Arguments

Applicant has amended the claim language to include "having at least a tapered end longitudinally spaced from said couplings" and cancelled claims 5 and 12.

Examiner's Response to Arguments

Ostensibly, the added limitation is disclosed in Figure 5 of Watanbe.



Lastly, the specificity found in Applicant's specification particularly the sectional finned structure and the conical structure with members 11, 12, and 17 are not found in the claim language.

Applicant is reminded to see MPEP 2111. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." Thus, the claim is not limited to such interpretation and the rejection still holds.

As such, this action is made final.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH COLEMAN whose telephone number is (571)270-3516. The examiner can normally be reached on 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Cronin can be reached on (571)272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. C./
Examiner, Art Unit 3747

/Mahmoud Gimie/
Primary Examiner, Art Unit 3747

